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In re Application of :
Conrad Alexander et al. :
Application No. 08/421,810 : ON PETITION
Filed: April 13, 1995 :
For: INTELLIGENT LOCATOR SYSTEM :

This is a decision on the petition filed September 21, 1998, requesting under 37 CFR 1.183 suspension of the rules of practice which operate to prohibit entry of the amendment of March 4, 1998 which adds claims for the purpose of provoking an interference with a patent.[1]

The petition under 37 CFR 1.183 is dismissed.

Petitioner requests that the rules be waived such that the aforementioned amendment may be entered. Specifically, petitioner notes that the patent in question issued subsequent to close of prosecution and onset of the appellate review process. As such, petitioner seeks waiver of the rules.

In order for grant of a petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rules. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case.

A party does not have a right to an adversary proceeding, including the declaration of an interference, which is a matter of the Commissioner's discretion. See Doyle v. Brenner, 383 F.2d 210, 154 USPQ 464 (D.D.C. 1967). Rather, "an examiner must determine that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant..." See 37 CFR 1.606. That is, even assuming *arguendo*, the amendment were entered, such does not warrant a

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[1] The petition, also treated under 37 CFR 1.181(a)(3) as requesting review of the examiner's refusal to enter the aforementioned amendment, has been denied in the decision of the Director mailed February 16, 1999.

conclusion that the requested interference would be forthcoming in due course. In addition to the reasons set forth by the Director, as there are currently no allowed claims in the instant application, it is problematic that an interference would be declared without the expenditure of considerable time and effort long after the rules of practice compel such further allocation of the limited resources of the PTO to the examination of this application. As noted in Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 29 (CCPA 1964):

> "We think it apparent, however, that Congress did not intend that applicant should be able to "prosecute" his application indefinitely before the Patent Office. An orderly administrative process demands an end to prosecution."

Moreover, the PTO will not normally consider an extraordinary remedy, where, as here, the rules already provide an avenue for obtaining the relief sought. As such, any further consideration of the issues raised under 37 CFR 1.183 is moot. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). That is, as noted in the decision of the Director (at 2), the rules of practice adequately provide for consideration of the above-noted amendment, and any forthcoming interference, in a continuing application filed pursuant to 37 CFR 1.53(b).

While it is recognized that any continuing application which claims benefit of the instant application under 35 USC 120 will be subject to a shortened term, should a patent be granted thereto, as provided by 35 USC 154(a)(2), and also due to any interference, the latter delay may be subject to an offset if requested under the terms of 35 USC 154(b)(1). Moreover, petitioner had, but did not seek, the alternate option of presenting the copied claims at issue in a concurrently filed reissue application of parent U.S. Patent No. 5,426,425, which parent case presumably has the same disclosure as the instant continuation application. See e.g., In re Clement, 131 F.3d. 1464, 45 USPQ2d 1161 (Fed. Cir 1997). A reissue application would not have been subject to such shortening of term.

The file is being returned to the Board of Patent Appeals and Interferences.

Telephone inquiries concerning this matter may be directed to the Special Projects Examiner Brian Hearn at (703) 305-1820.

Brian Hearn

Abraham Hershkovitz, Director
Office of Petitions
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for Patent Policy and Projects